

The opinion in support of the decision being entered today is *not* binding  
precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHELLE Q. WANG BALDONADO, PAULA S. NEWMAN,  
and WILLIAM C. JANSSEN JR.

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Appeal 2007-1438  
Application 09/717,278<sup>1</sup>  
Technology Center 2100

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Decided: August 14, 2007

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*Before* JOHN C. MARTIN, ALLEN R. MacDONALD, and MARC S.  
HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of  
claims 1-8, 10-14, and 16-25. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> Application filed November 22, 2000. The real party in interest is Xerox Corp.

Appellants' invention relates to a system and method for sender-independent digesting and sampling of electronic messages from an "information stream," which may include electronic messages such as e-mail messages or any serial message stream or serial database recording system events (Specification 9:19-20). The digest tool of the invention allows a user to specify criteria identifying candidate messages for a "digest," defined as a compilation of electronic messages (Specification 1:30-2:8).

Claim 1 is exemplary:

1. An electronic message management system comprising:

a digest specification device that allows a user to obtain a plurality of digests from an information stream comprising a plurality of candidate messages by allowing the user to specify a set of one or more sender-independent message-based rules for each digest, wherein each set of one or more sender-independent message-based rules specifies one or more characteristics of the candidate messages;

an information selection device that monitors the information stream and selects one or more of the plurality of candidate messages in the information stream that satisfy all of the rules in at least one of the sets of sender-independent message-based rules for at least one of the plurality of digests; and

an electronic message management device that determines, for each of the selected candidate messages, which of the plurality of digests corresponds to the set of sender-independent message-based rules satisfied by the particular selected candidate message, that integrates each of the selected candidate messages into their respective corresponding digests, and that determines and updates the digest based on one or more of the sender-independent message-based rules that specify characteristics of the digest.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Simoni Jr.

GB 2 324 627 A

Oct. 28, 1998

(Appellants and the Examiner refer to the UK Patent Application of Simoni, Jr. as “Pan.” We follow the same convention.)

Claims 1-8, 10-14, and 16-25 stand rejected under 35 U.S.C. § 102(b) as being obvious over Pan.

Appellants contend that the Examiner erred in holding the claims to be anticipated, because Pan does not teach digests obtained from an information stream; does not disclose sender-independent rules; does not obtain a plurality of digests from an information stream comprising a plurality of candidate messages; and obtains digests from a newsgroup server rather than the claimed “information stream.” The Examiner contends that the claims are properly rejected because Pan meets every claim limitation.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).<sup>2</sup>

#### ISSUE

The principal issue in the appeal before us is whether the Examiner erred in holding that Pan meets all the limitations of the claims, especially

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<sup>2</sup> Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

(a) obtaining a plurality of digests from an information stream; (b) allowing the user to specify a set of one or more sender-independent message-based rules for each digest; (c) obtaining a plurality of digests ... from a plurality of candidate messages; and (d) that digests are obtained directly from an information stream, with no intermediary step or device.

### FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

#### *The Invention*

1. Appellants invented a system and method for performing sender-independent digesting and sampling of electronic messages from an information stream (Specification 1:30-32). The user may control when messages are received, how messages are grouped, and whether to receive or filter out a particular message (Specification 2:1-2).

2. The digest tool of the invention allows the user to specify message-based criteria for which messages to include in a digest. Criteria may include formatting, delivery date, frequency, or structural organization (Specification 2:6-8).

3. Appellants define “digest” as “a compilation of electronic messages” (Specification 2:5), or as a “set[s] of electronic messages” (Specification 2:29), or as a collection of electronic messages sent as a single message at regular intervals, so as to minimize interruptions (Specification 4:5-6).

4. Appellants define “information stream” as including, “for example, electronic messages such as e-mail messages, or any serial

message stream or serial database recording system events” (Specification 9:19-20).

5. The sampling tool allows a user to select which messages are actually received; for example, the user may configure the tool to send only every  $n^{\text{th}}$  message that meets candidate criteria, send a message only when there is a topic shift in the message stream, or send a message when the message receives a large number of responses (Specification 2:10-19).

#### *Pan*

6. Pan teaches an enhanced interface to news and chat forums, including the ability to create “custom newsgroups” by applying filtering criteria across several newsgroups (Pan 33:1-2).

7. One example of Pan’s filtering criteria is the creation of a custom newsgroup that consists of all articles in all newsgroups related to stock investing that include the word “penny” (Pan 33:10-12).

8. Pan’s sample display of a custom newsgroup shows a list of topics of those messages meeting the user’s filtering criteria. (Pan Fig. 7).

9. Pan teaches that electronic news systems such as USENET are known, in which users post articles to newsgroups, and read and respond to articles posted by other users. Each article and response is archived for a period of time, allowing users to participate in discussions in a non-real time fashion (Pan 1:13-22).

#### PRINCIPLES OF LAW

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342,

1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

## ANALYSIS

Appellants argue that Pan fails to anticipate claim 1 because (a) the claim requires obtaining a plurality of digests by selecting one or more candidate messages in an information stream, whereas Pan teaches a newsgroup, which is static content, unlike a plurality of messages selected from an information stream; (b) Pan fails to disclose filtering criteria for selecting candidate messages which are sender-independent, because the sender of the messages in Pan is the newsgroup from which the message is selected; (c) Pan selects messages from among plural newsgroups, to be included in one custom newsgroup, whereas the claim requires obtaining a plurality of digests from an information stream comprising a plurality of candidate messages; and (d) claim 1 requires obtaining digests from an information stream, while in Pan messages must go through an intermediary newsgroup, rather than being obtained directly from such a “stream”. We address each argument in turn.

### *Pan discloses digests*

We disagree that Pan fails to disclose digests. Appellants describe a digest at one point as “a compilation of electronic messages,” or as a “set[s] of electronic messages,” or as a collection of electronic messages sent as a single message at regular intervals so as to limit interruptions (FF 3). Pan teaches the creation of “custom newsgroups,” made up of messages that satisfy user-defined criteria (FF 6). Figure 7 of Pan shows that a custom newsgroup appears to the user as a single display window of message topics

meeting the criteria (FF 8). That collection of messages is certainly a “compilation” or “set,” and may also be retrieved by the user at times of his own choosing, which would limit interruption in the same manner as Appellants’ digests.

We further disagree that the newsgroups of Pan are distinct from Appellants’ “information stream,” because newsgroups are static content and the stream is not. We do not perceive such a distinction. Appellants disclose that the information stream “can include, for example, electronic messages such as e-mail messages, or any serial message stream or serial database recording system events” (FF 4). Newsgroups are made up of individual electronic messages, posted by users worldwide, on a particular topic (FF 9). New postings may be made at any moment, and newsgroup reader software, just like e-mail client software, may be configured to retrieve new messages at an interval selected by a user.

*Pan discloses sender-independent rules*

Appellants argue that the filtering criteria used in Pan to assemble custom newsgroups are “dependent upon the originator of each message, which is either a newsgroup or newsgroup hierarchy” (Br. 8:24-25). In fact, the originator of each message in a newsgroup is the person who originally posted the message to the newsgroup (FF 9). Appellants admit that the messages that find their way into a custom newsgroup originate first from a user (Br. 9:28). Pan gives a specific example of a custom newsgroup composed of all messages “related to stock investing that include the word ‘penny’” (FF 7). We therefore find evidence in Pan that sender-independent filtering criteria may be used to assemble a custom newsgroup.

*Pan is many-to-many*

Appellants argue that Pan does not anticipate the claimed invention because Pan teaches including one or more messages from a plurality of newsgroups in a single custom newsgroup, whereas Appellants' invention obtains a plurality of digests from an information stream comprising a plurality of candidate messages. Because Pan discloses that “[c]lient applet 112 may be extended to provide custom newsgroups” (emphasis added) (FF 6), we find that Pan does teach obtaining a plurality of digests from an information stream comprising a plurality of candidate messages.

*Pan's newsgroups are analogous to an information stream*

Appellants argue that Pan does not obtain a plurality of digests from an information stream, because in Pan a message originates first from a user, then is stored in an (intermediary) newsgroup, and finally is filtered against criteria (Br. 9:27-29). We note that nothing in the claims requires that information not be stored, or not have any other component interposed between its origination and its destination in a “digest.” Further, we fail to perceive a difference between the operations in Pan and those in Appellants' system. We note that electronic mail messages, one of the exemplary components of Appellants' information stream, also originate first from a user, then are stored in a mail server before delivery to a recipient, just like the newsgroup postings at issue in Pan. Thus, we find that Pan does teach obtaining a plurality of digests from an information stream, as recited in claim 1.

Because Appellants have not persuasively demonstrated that Pan fails to meet any limitation of claim 1, Appellants have failed to show that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102.



*Claim 2*

Appellants argue that Pan fails to anticipate claim 2 because Pan does not disclose a device that delivers a digest to a predetermined destination upon satisfaction of at least one set of sender-independent message-based rules. As discussed *supra*, however, Pan does create a digest, in the form of a custom newsgroup displayed as a list of topics, which is presented on a user's display (i.e., delivered to such display) based on a set of sender-independent message based rules (for example, select every message that uses the word "penny"). Pan therefore teaches every limitation of claim 2, and Appellants have failed to show that the Examiner erred in rejecting claim 2 under 35 U.S.C. § 102(b).

**The remaining claims**

Appellants purport to separately argue independent claims 7, 13, and 19. However, Appellants merely present the very same arguments presented with respect to claim 1; state the features of each of these claims; and allege, without explaining why, that the additional features render each claim separately patentable.

37 C.F.R. § 41.37 (c) (1) (vii) states that "[a] statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."

Appellants have not discussed why the evidence would support a holding that claims 7, 13, and 19 are patentable apart from claim 1.

Furthermore, Appellants' arguments regarding dependent claims 8 and 14 are unconvincing for the reasons given above in the discussion of dependent claim 2.

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As Appellants have not separately argued any of dependent claims 3-6, 10-12, 16-18, and 20-25, those claims fall with their parent claims.

Because Appellants have not shown that the Examiner has failed to make out a prima facie case of anticipation, we will sustain the Examiner's rejection of claims 1-8, 10-14, and 16-25 under 35 U.S.C. § 102(b).

#### CONCLUSION OF LAW

We conclude that Appellants have not shown the Examiner erred in rejecting claims 1-8, 10-14, and 16-25. Claims 1-8, 10-14, and 16-25 are unpatentable.

#### DECISION

The Examiner's rejection of claims 1-8, 10-14, and 16-25 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

#### AFFIRMED

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CASCADIA INTELLECTUAL PROPERTY  
500 UNION STREET  
SUITE 1005  
SEATTLE WA 98101